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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/972,181

10/05/2001

Dusan Miljkovic

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11/05/2004

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/972,181

**Applicant(s)**

MILJKOVIC, DUSAN

**Examiner**

Taylor Victor Oh

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

The Status of Claims

Claims 1-20 are pending.

Claims 1-20 are rejected.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the terms "an oxidizable compound", "an electrophilic compound", "an electron donating group", "a complex", and "a second stability towards the oxidation" are recited. They are vague and indefinite because the claims do not define what each of them is with respect to its chemical structure and its functional group ; and furthermore, it is uncertain as to how they are arranged with respect to their spatial arrangement among the electrophilic compound and the electron donating group by forming the complex. Moreover, the phrase "a second stability towards the oxidation" is

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unclear because there is no description in the claim as to how the first stability is different from the second stability. In addition, the claim is the Reach-Through Claim. The claim does read on the future oxidizable compounds and electrophilic compounds, and electron donating groups which have not discovered yet. In order to overcome this rejection, the examiner recommends to add the specific oxidizable compounds and electrophilic compounds, and electron donating groups to the instant claim. Therefore, an appropriate correction is required.

In claim 2, the phrase "R' and R" optionally comprise" is recited.

The expression is vague and indefinite because "R' and R" optionally comprise" would mean that there are other additional components besides the only R' and R" group. Therefore, an appropriate correction is required.

In claim 3, the phrases "the oxidizable compound further comprises" and "a first electron donating group and a second electron donating group" are recited. The expressions are vague and indefinite. This is because "the oxidizable compound further comprises" would mean that there are other additional components besides the only oxidizable compound; furthermore, there is uncertain as to what they are respectively and which the electron donating group is the first one relative to the second electron donating group in the structurally unknown oxidizable compound. In addition, the claim is the Reach-Through Claim. The claim does read on the future oxidizable compounds

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which have not discovered yet. In order to overcome this rejection , the examiner recommends to add the specific oxidizable compounds to the instant claim.

Therefore, an appropriate correction is required.

In claim 4, the phrases “ the electron donating group and a second electron donating group” are recited. The expressions are vague and indefinite. This is because there is uncertain as to which the electron donating group is the first one relative to the second electron donating group in the structurally unknown oxidizable compound. In addition, the claim is the Reach-Through Claim. The claim does read on the future electron donating groups which have not discovered yet. In order to overcome this rejection , the examiner recommends to add the specific electron donating groups to the instant claim.

Therefore, an appropriate correction is required.

In claim 5, the phrases “ the electron donating group” and “ the oxidizable compound” are recited. The expressions are vague and indefinite. This is because there is uncertain as to which the electron donating group is and what the structurally unknown oxidizable compound is. In addition, the claim is the Reach-Through Claim. The claim does read on the future oxidizable compounds and electron donating groups which have not discovered yet. In order to overcome this rejection , the examiner recommends to add the specific oxidizable compounds and electrophilic compounds,

and electron donating groups to the instant claim. Therefore, an appropriate correction is required.

In claim 7, the phrase "the electron-donating group" is recited. The expression is vague and indefinite because of its Reach-Through Claim. The claim does read on the future electron donating groups which have not discovered yet. In order to overcome this rejection, the examiner recommends to add the specific electron donating groups to the instant claim. Therefore, an appropriate correction is required.

In claims 8, 19, and 20, the phrase "the electrophilic compound comprises" is recited. The expression is vague and indefinite because "the electrophilic compound comprises" would mean that there are other additional components besides the only "the electrophilic compound. In addition, the claim is the Reach-Through Claim. The claim does read on the future electrophilic compounds which have not discovered yet. In order to overcome this rejection, the examiner recommends to add the specific electrophilic compounds to the instant claim. Therefore, an appropriate correction is required.

In claim 14, the phrase "the oxidizable compound" is recited. The expression is vague and indefinite because of its Reach-Through Claim. The claim does read on the future oxidizable compounds which have not discovered yet. In order to overcome this

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rejection , the examiner recommends to add the specific oxidizable compounds to the instant claim. Therefore, an appropriate correction is required.

In claim 17, the terms "a compound" , "an oxidizable compound" , "an electrophilic compound", " an electron donating group", and "a complex" are recited. They are vague and indefinite because the claims do not define what each of them is with respect to its chemical structure and its functional group ; and furthermore, it is uncertain as to how they are arranged with respect to their spatial arrangement among the electrophilic compound and the electron donating group by forming the complex. Moreover, the phrase "a second stability is greater than the first stability" is unclear because there is no description in the claim as to how much the second stability is greater than the first stability. In addition, the claim is the Reach-Through Claim. The claim does read on the future oxidizable compounds and electrophilic compounds which have not discovered yet. In order to overcome this rejection , the examiner recommends to add the specific oxidizable compounds and electrophilic compounds to the instant claim. Therefore, an appropriate correction is required.

In claim 18, the phrases " the electron donating group and a second electron donating group" are recited. The expressions are vague and indefinite. This is because there is uncertain as to what they are respectively and which the electron donating

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group is the first one relative to the second electron donating group in the structurally unknown oxidizable compound. Therefore, an appropriate correction is required. In addition, the claim is the Reach-Through Claim. The claim does read on the future electron donating group which have not discovered yet. In order to overcome this rejection, the examiner recommends to add the specific electron donating group to the instant claim. Therefore, an appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mckane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Signature of Taylor Victor Oh*  
10/21/04

*Signature of Cecilia J. Tsang*  
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